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09/667,723	09/22/2000	Hiroyuki Yoshizawa	1614.1077	9382

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EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/667,723	YOSHIZAWA, HIROYUKI
	Examiner Melvin H Pollack	Art Unit 2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 June 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-28 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: *see attached office action*.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant has added new limitations to all independent claims, and has thus changed the scope of the claims. Thus, this office action is final as necessitated by amendment.
3. A problem has arisen in which an IDS was delivered on December 31, 2002, before the office action was mailed, but after the office action was completed and entered into the record. As such, the examiner could not reasonably have been expected to consider the IDS at the time of entry, and will be considering said IDS at this time.
4. As it would have been unreasonable to consider the IDS after the office action was completed and entered, it would thus be unreasonable to expect the examiner to punish himself for what is an unfortunate accident not of his making. However, in the interest of simplifying the issues of this case, the examiner will not use Shepley et al. at this time, but reserves the right to use said document in subsequent office actions. As for Dawson, this document was discovered by the examiner independently of the IDS, and used in an office action prior to US filing. As such, the use of said document is allowed.
5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the thumbnail image is not input separately from the e-mail address") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (6,252,588) in view of "V's Email Sig HTML".

8. For claim 1, Dawson teaches an electronic apparatus (see abstract) comprising a transmitter transmitting an electronic mail (Fig. 4, #413 and col. 7, lines 34-35) in which a symbol including image information, which enables a sender to be specified therefrom is included within an electronic signature file of the electronic mail (col. 7, lines 65-66).

9. The examiner interprets from the specification that the applicant means the signature file as defined in the McGuinness article rather than the digital/electronic signatures as defined in the DSS standard.

10. Applicant amended to add that the signature file includes an email address of the sender. Dawson teaches that the signature file is a picture. As a design choice, said picture may be exclusively or partly an image of an email address, as claim 1 does not specify that the email address is separate from the image information, nor does it specify that it cannot be an image. That said, it is made clear from the V article that an email signature file can be an HTML web page that mixes image information (and even multimedia information) (Page 4, code block) with

text information (Page 6) including URLs (Page 5, last paragraph). As the insertion of email addresses into web pages are well known in the art, this feature is considered obvious. At the time the invention was made, one of ordinary skill in the art would have used V's email signature file in place of Dawson's signature file in order to include more types of information.

11. As for claim 2, Dawson teaches that there is a generator generating the image information (col. 10, lines 43-44) by inputting an image of the sender (col. 16, lines 58-63).

12. As for claim 4, Dawson teaches that the image information includes an image related to at least a face of the sender (col. 16, line 59).

13. As for claim 5, Dawson teaches that there is an adding unit adding to the signature information a parameter which indicates an importance of the electronic mail (col. 2, lines 11-17).

14. As for claim 7, Dawson teaches that the parameter includes information which indicates a display priority order of the electronic mail (col. 2, lines 15-17).

15. As for claim 8, Dawson teaches that the parameter includes character, image, and/or audio information indicating a summary of the electronic mail (col. 8, lines 3-5 and col. 17, lines 40-46).

16. As for claim 10, Dawson teaches that the symbol includes information used for linking to the sender (col. 20, lines 51-61 and col. 27, lines 45-51).

17. Claim 11 is an electronic apparatus comprising the receiver of the message produced with the claim 1 apparatus, and the ability to display the image. Dawson teaches the reception of the message, and its display (Fig. 10). Further, the prior art shows that certain actions automatically anticipate complementary actions. For example, if a device transmits a message, it is anticipated

that there must be a device that receives the message, and vice versa. Therefore, if claim 1 is rejected, then claim 11 must also be rejected for the reasons above.

18. Claims 12 and 13 are complementary receiving systems to the transmitting system drawn in claims 4 and 5, respectively. As shown before, it is anticipated to produce a reflected system. Therefore, if claims 4 and 5 are rejected, then claims 12 and 13 are also rejected for the reasons above. A similar rejection is made of claim 16, which also shares many of the same limitations as claim 13.

19. Claims 19 and 20 are complementary receiving systems to the transmitting system drawn in claims 8 and 10, respectively. As shown before, it is anticipated to produce a reflected system. Therefore, if claims 8 and 10 are rejected, then claims 19 and 20 are also rejected for the reasons above.

20. Claim 21 is drawn to many of the same limitations drawn in claims 11 and 13. If claims 11 and 13 are rejected, then claim 21 is also rejected for the reasons above.

21. Claim 22 is drawn to many of the same limitations drawn in claims 1 and 5. If claims 1 and 5 are rejected, then claim 22 is also rejected for the reasons above.

22. Claims 23 and 24 are drawn to a control apparatus for the electronic apparatus drawn in claims 1 and 11, respectively. Dawson teaches this as well (Fig. 1 and 18). Further, it is anticipated that the apparatus described above could not operate without some sort of mechanism that controls the transmitter to transmit certain content at certain times. Therefore, if claims 1 and 11 are rejected, then claims 23 and 24 are also rejected for the reasons above.

23. Claims 26 and 27 are drawn to a computer-readable storage medium which stores a program for causing a computer to implement the system drawn in claims 1 and 11, respectively.

The prior art teaches that a hardware implementation is functionally equivalent to a software implementation. It is also anticipated that a program would be stored on a computer-readable medium. Therefore, if claims 1 and 11 are rejected, claims 26 and 27 are also rejected for the reasons above.

24. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson and V's Signature as applied to claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27 above, and further in view of Lu et al. (5,432,864).

25. As for claim 3, Dawson does not expressly disclose that the transmitter transmits the electronic mail only when an error between the image information generated by said generator and prestored image information is within a predetermined range. Dawson does disclose, however, a camera (col. 27, lines 55-60) and a database of pictures, as shown above. Lu teaches that a system is accessed when a person's face is compared with a stored image and approved (Fig. 3). Examiner notes that applicant's claims do not specify the method of storage, although more conventional storage is available (Fig. 7, #40). The purpose of Lu is a generic identity check device which can be used for a wide variety of causes (col. 1, lines 15-17). At the time the invention was made, one of ordinary skill in the art would have used the Lu authentication system in order for a user to access the mail account. The equipment and prior photos would already have been activated. In addition, it would make the system more user friendly, a motivation of Dawson (col. 7, lines 34-35) by removing the need to remember passwords, log-in names, and/or IP addresses.

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26. Claims 6, 9, 14, 15, 17, 18, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson and V's Signature as applied to claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, 27 above, and further in view of the WarpSpeedHelp article on Web Page Embedding.

27. As for claim 6, Dawson does not expressly disclose the parameter indicates the importance of the electronic mail by a display format of the signature information. However, Dawson and the other items have shown that the signature in this case is only a grouping of text, image, and audio information, ordered in a certain way. As such, it can be thought of as a small web page embedded in an email document. The embedding article teaches how to embed a web page in an email. But such a page can be embedded in the beginning, middle or end of the email text. Therefore, it can be used to place a signature-type file anywhere in the document, rather than simply attaching it to the end. At the time the invention was made, one of ordinary skill in the art would have added this functionality to Dawson for aesthetic purposes.

28. As for claim 9, Dawson does not expressly disclose that the information which indicates the display priority order of the electronic mail includes at least one of a display position and a display timing of the signature information. However, the display position information would have been included for the reasons above. The display timing embedding mechanism is shown in full detail in the Tripod article (Page 5, only picture). At the time the invention was made, one of ordinary skill in the art would have combined the teachings for the reasons above.

29. Claim 14 is a complementary receiving system to the transmitting system drawn in claims 5 and 6. As shown before, it is obvious to produce a reflected complementary system. Therefore, if claims 5 and 6 are rejected, then claim 14 is also rejected for the reasons above.

30. Claim 15 is a complementary receiving system to the transmitting system drawn in claim 7. As shown before, it is obvious to produce a reflected complementary system. Therefore, if claim 7 is rejected, then claim 15 is also rejected for the reasons above.

31. Claims 17 and 18 are a complementary receiving system to the transmitting system drawn in claims 9 and 7, respectively. As shown before, it is obvious to produce a reflected complementary system. Therefore, if claims 7 and 9 are rejected, then claims 17 and 18 are also rejected for the reasons above.

32. Claim 25 is drawn to a control apparatus for the electronic apparatus drawn in claim 14. Dawson teaches this as well (Fig. 1 and 18). Further, it is obvious that the apparatus described above could not operate without some sort of mechanism that controls the transmitter to transmit certain content at certain times. Therefore, if claim 14 is rejected, then claim 25 is also rejected for the reasons above.

33. Claim 28 is drawn to a computer-readable storage medium which stores a program for causing a computer to implement the system drawn in claim 14. The prior art teaches that a hardware implementation is functionally equivalent to a software implementation. Official notice is taken that a program would be stored on a computer-readable medium. Therefore, if claim 14 is rejected, claim 28 is also rejected for the reasons above.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

35. Digital Signatures: Powers (6,446,115 and 6,438,584), Harker et al. (6,209,005)

36. Image Information w/E-mail: Holleran et al. (5,752,059), Linstead et al. (5,548,753)

37. Business Card Information Sharing via E-mail Signature: Dickinson (5,732,229), Porter (6,533,171)

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703)305-4003. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

MHP
July 30, 2003



ROBERT B. HARRELL
PRIMARY EXAMINER